

REMARKS

This is a full and timely response to the non-final Official Action mailed **May 1, 2008** (the “Action” or “Office Action”). Reconsideration of the application in light of the following remarks is respectfully requested.

Claim Status:

By the foregoing amendment, claims 1, 2, 11, 20 and 22 have been amended. No new matter has been added. No additional claims are added nor are any existing claims cancelled by the present paper. Thus, claims 1-25 are currently pending for further action.

Prior Art:

Claims 1-25 were rejected under 35 U.S.C. § 103(a) as obvious in light of the combined teachings of U.S. Patent App. Pub. No. 2002/0109867 to Sesek et al. (“Sesek”) and U.S. Patent No. 6,204,937 to Takeda (“Takeda”). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 1 now recites:

An image reproduction apparatus comprising:
a transparent scanning bed;
a scanning device optically coupled to said scanning bed, *said scanning device comprising a photoconductive platen configured to receive light reflected off of an object on said scanning bed*; and
an adjustable shade associated with said scanning bed;
wherein said adjustable shade is configured to be selectively extended from a position adjacent said scanning bed to cover a portion of said scanning bed including from an edge of said scanning bed to a leading edge of said adjustable shade, an underside of said shade presented to said scanning device through said bed being colored *such that substantially no light is reflected onto said photoconductive platen*

when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.
(Emphasis added.)

Support for the amendment to claim 1 can be found in the Specification as originally filed by the Applicant at, for example, paragraphs 0024, 0030 and Figs. 2-4, 5B and 6B.

In contrast, Sesek teaches the following. “An apparatus and system for scanning a bounded scan area within a scanable [sic] surface of a scanning device are provided. The present invention includes a plurality of members constructed and arranged to define a scan area on a scanable [sic] surface of the scanner, a link for communicating with the control interface of the scanner, and a switch for generating a signal to the control interface to initiate and complete a scan of the bounded scan area defined by the plurality of members.” (Sesek, abstract).

Accordingly, Sesek does not appear to teach the claimed adjustable shade that is selectively extended to cover a portion of scanning bed *from the edge of the bed to a leading edge of the shade*. Rather, Sesek teaches a scanner with “a plurality of members constructed and arranged to define a scan area on a scanable surface of the scanner, a link for communicating with the control interface of the scanner, and a switch for generating a signal to the control interface to initiate and complete a scan of the bounded scan area defined by the plurality of members.” (Sesek, abstract). Accordingly, Sesek teaches pointers (Fig. 3) or bars (Fig. 1) that are only used to define an area to be scanned, not to cover or shade a portion of the scanning bed *from the bed's edge to a leading edge of the shade*, as claimed.

To further illustrate this point, Figs. 1 and 3 of Sesek are reproduced below. As can be clearly seen from these figures, the bars (Fig. 1) or the pointers (Fig. 3) are used merely to indicate electronically a portion (14') of the scanning bed (11) that is to be scanned. The bars

and pointers of SeseK are not capable of masking or obscuring portions of the scanning bed where no image is to be captured.

Specifically, neither the pointers nor bars of SeseK can be reasonably construed as an adjustable shade “wherein said adjustable shade is configured to be selectively extended from a position adjacent said scanning bed to cover a portion of said scanning bed including from an edge of said scanning bed to a leading edge of said adjustable shade.” (Emphasis added).

As can be clearly seen in either Fig. 1 or Fig. 3, after the pointers or bars are deployed, there are portions of the scanning bed between the edges of the bed and the bars (15) for example, that are *not covered*. This is clearly contrary to the highlighted recitations of claim 1.

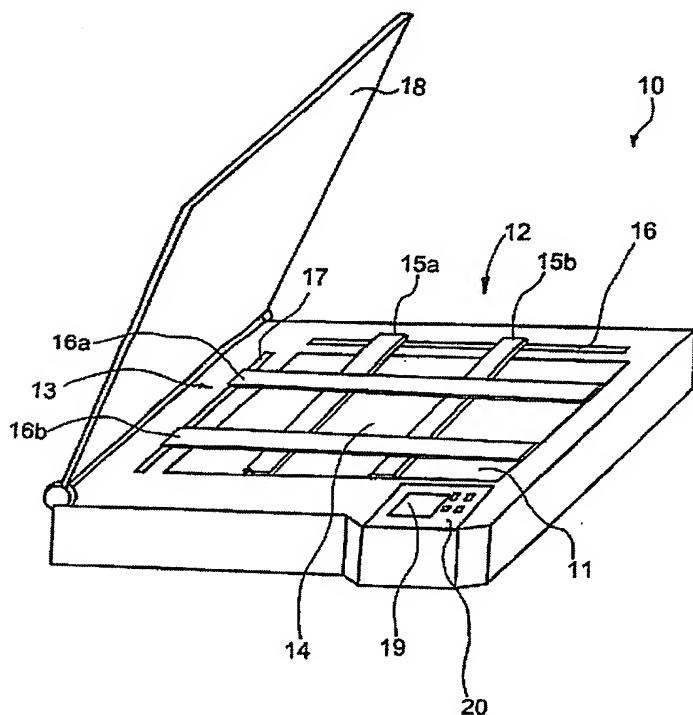


FIG.1

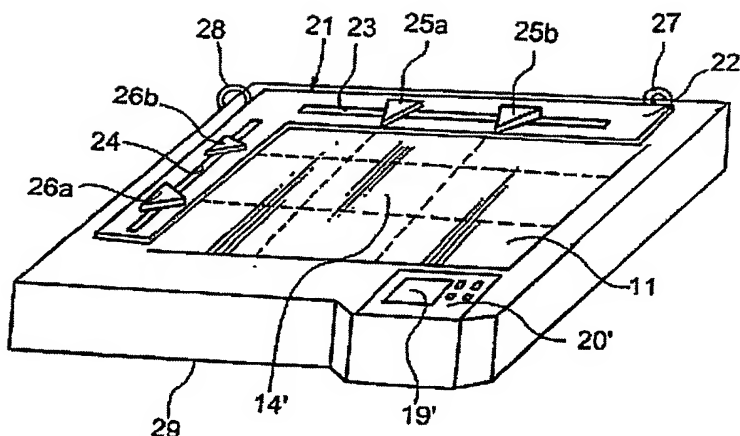


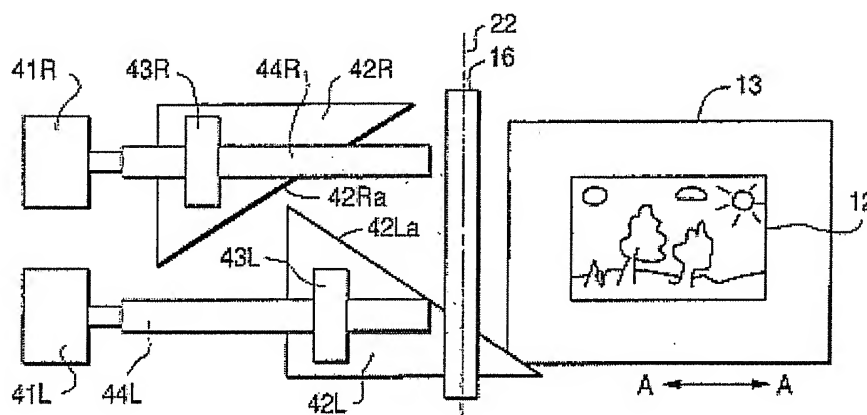
FIG.3

Additionally, Sesek does not appear to teach or suggest that when the adjustable shade is extended to cover a portion of the scanning bed, that “an underside of said shade presented to said scanning device through said bed [is] colored such that said substantially no light is reflected onto said photoconductive platen when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.” (Claim 1). Rather, Sesek teaches an “apparatus, system and method [that] *scans only a user defined enclosed scan area*, instead of the scanning device scanning the entire scanable surface without additional user manipulation.” (Sesek, paragraph.0037) (emphasis added).

Takeda teaches the following. “[T]he image reading device has light shielding plates 42L and 42R which are positioned to one side of original cassette 13. Nuts 43R and 43L are attached to light shielding plates 42R and 42L, respectively, Nuts 43R and 43L are threaded onto screws 44R and 44L, respectively.” (Takeda, col. 5, lines 54-67). Takeda further teaches the “light shielding plates 42L and 42R are formed such that their inner sides 42La and 42Ra are angled with respect to the sub-scan direction” such that “the position at which the light from light source 16 is shaded changes as the plates are moved in relationship to pixel

scanning line 22.” (Takeda, col. 6, lines 15-19). For reference, Fig. 8 of Takeda is reproduced below.

FIG. 8



As can be seen in the above reproduction of Fig. 8, Takeda teaches the use of light shielding plates that 42R, 42L that are selectively advanced and retracted along axis A-A as a cassette 13 transports an original 12 along an axis A-A past a stationary scanning light source 16 that transmits light through the original 12 on the cassette 13 to detecting elements positioned beneath the cassette 13. (Takeda, Fig. 2, col. 6, lines 6-22). Clearly, Takeda does not teach or suggest the image reproduction apparatus of claim 1 having a scanning device that comprises “a photoconductive platen configured to receive light reflected off an object on said scanning bed.” (claim 1). In contrast, Takeda teaches that scanning light is transmitted *through* the original 12 to detection elements below the cassette 13. Accordingly, Takeda does not teach or suggest that light shielding plates 42R, 42L “cover a portion of said scanning bed including from an edge of said scanning bed to a leading edge of said adjustable shade” such that “substantially no light is reflected onto said photoconductive platen when

scanning said underside of said shade.” (Claim 1). To the contrary, the light shielding plates 42R, 42L of Takeda are arranged such that, in the event light were transmitted from below onto original 12, the light shielding plates 42R, 42L would not prevent any light from being reflected anywhere, as the light shielding plates 42R, 42L are only functional when light is transmitted through an original 12 from above.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Sesek and Takeda, did not include the claimed subject matter, particularly an adjustable shade that is “configured to be selectively extended from a position adjacent said scanning bed to cover a portion of said scanning bed including from an edge of said scanning bed to a leading edge of said adjustable shade, an underside of said shade presented to said scanning device through said bed being colored such that substantially no light is reflected onto said photoconductive platen when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.” (Claim 1).

The differences between the cited prior art and the claimed subject matter are significant because the system recited by claim 1 provides a way to shield desired areas of a document from being scanned by a scanning device without requiring the transmission of light through the document from above, as taught by Takeda, or configuring a scanner device to only scan a user-defined area of the document, as taught by Sesek. Thus, the claimed subject matter provides feature and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 1 under 35 U.S.C. §

103 and *Graham*. For at least these reasons, the rejection based on Sesek and Takeda of claim 1 and its dependent claims should be reconsidered and withdrawn.

Claim 11 recites:

A method of adjusting the target area of an image reproduction apparatus comprising:
selectively covering an edge of a scanning bed by drawing a shade over said edge of said scanning bed;
placing said object on said drawn shade; and
scanning said object;
wherein an underside of said shade that is presented to said scanning bed is colored such that said scanning outputs no image of said underside of said shade thereby effectively reducing a size of said scanning bed.

(Emphasis added).

In contrast, as demonstrated above, Sesek does not teach or suggest a method of adjusting a target area of an image reproduction apparatus by “selectively covering an edge of scanning bed by drawing a shade over said edge of said scanning bed.” Sesek teaches markers for defining an area to be scanned, not for selectively covering an edge of the scanning bed in the manner claimed.

Moreover, as discussed above, Sesek does not teach or suggest “wherein an underside of said shade that is presented to said scanning bed is colored such that said scanning outputs no image of said underside of said shade thereby effectively reducing a size of said scanning bed.” The recent Office Action fails to indicate how or where Sesek specifically teaches this subject matter. As Sesek does not teach or suggest these steps, Sesek *cannot* teach or suggest the step of “placing an object on said drawn shade.” (Claim 11).

Furthermore, Takeda does not teach or suggest the step of “placing said object on said drawn shade.” (Claim 11). In contrast, Takeda teaches that an original 12 is placed in a cassette 13, and that light shielding plates 42R and 42L are independently suspended by nuts

43R, 43L and screws 44R, 44L between a light source 16 and the cassette 13. (Takeda, col. 5, line 54 to col. 6, line 24; *see also* Fig. 8). As such, Takeda *cannot* teach or suggest the step of “placing an object on said drawn shade.” (Claim 11).

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Sesek and Takeda, did not include the claimed subject matter, particularly a method of adjusting the target area of an image reproduction apparatus that comprises the steps of “selectively covering an edge of scanning bed by drawing a shade over said edge of said scanning bed” and “placing said object on said drawn shade.” (Claim 11).

The differences between the cited prior art and the claimed subject matter are significant because the system described by claim 11 provides a way to shield desired areas of a document from being scanned by a scanning device without requiring light shielding plates to be dynamically moved throughout the scanning processes, as taught by Takeda, or configuring a scanner device to only scan a user-defined area, as taught by Sesek. Thus, the claimed subject matter provides feature and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 11 under 35 U.S.C. § 103 and *Graham*. For at least these reasons, the rejection based on Sesek and Takeda of claim 11 and its dependent claims should be reconsidered and withdrawn.

Claim 14 recites:

An optical scanner with an adjustable shade comprising:
a shade reel disposed at an edge of a scanning bed of said optical scanner; and
a shade coupled to said shade reel;

wherein an underside of said shade that is presented to said scanning bed is colored such that said optical scanner does not output any image markings when scanning said underside of said shade thereby effectively reducing a scan target area of said optical scanner.

(Emphasis added).

Sesek clearly fails to teach or suggest the claimed “a shade reel disposed at an edge of a scanning bed of said optical scanner.” This fact was expressly conceded in a previous Office Action, which states that “Sesek does not disclose a shade reel.” (Action of 8/22/07, p. 8).

Furthermore, Takeda does not teach or suggest the claimed “a shade reel disposed at an edge of a scanning bed of said optical scanner.” In contrast, Takeda teaches that light shielding plates 42R and 42L are independently suspended by nuts 43R, 43L and screws 44R, 44L between a light source 16 and the cassette 13. (Takeda, col. 5, line 54 to col. 6, line 24; *see also* Fig. 8).

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Sesek and Takeda, did not include the claimed subject matter, particularly an optical scanner comprising “a shade reel disposed at an edge of a scanning bed of said optical scanner” and a “a shade coupled to said shade reel” (claim 14).

The differences between the cited prior art and the claimed subject matter are significant because the “shade reel” and “shade coupled to said shade reel” recited by claim 14 “allow a user to draw the shades across the top of the scanning bed thereby limiting the target area of the scanning device.” (Applicant’s specification, paragraph 0024). The systems taught by Sesek and Takeda do not allow a user to interact with shade elements in this

manner. Additionally, the system taught by Takeda requires the use of light shielding plates that are dynamically moved throughout the scanning processes by motors and Sesek requires the configuration of a scanner device to only scan a user-defined area. Both of these approaches require significant additional development and/or material resources that are not required by the optical scanner taught by claim 14. Thus, the claimed subject matter provides feature and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 14 under 35 U.S.C. § 103 and *Graham*. For at least these reasons, the rejection based on Sesek and Takeda of claim 14 and its dependent claims should be reconsidered and withdrawn.

Claim 20 recites:

A scanning device for eliminating unwanted areas of a scanned image, said scanning device comprising:
means for scanning; and
means for selectively covering edges of a scanning bed such that said means for scanning outputs no image markings when scanning said covered portions of said scanning bed;
wherein said means for covering edges of said scanning bed are configured to selectively *and statically* reduce an effective scanning area of said means for scanning. (Emphasis added).

Support for the amendment to claim 20 can be found in the Specification as originally filed by the Applicant at, for example, paragraph 0030, 0038-0039 and Fig. 8.

In contrast, as demonstrated above, Sesek does not appear to teach or suggest a scanning device like that claimed with “means for selectively covering edges of a scanning bed...wherein said means for covering edges of said scanning bed are configured to selectively and statically reduce an effective scanning area of said means for scanning.” Rather, Sesek teaches means for defining a smaller area within a scanning bed, where only the smaller defined area is scanned.

Moreover, as clearly seen in Fig. 1 of SeseK, reproduced above, when the bars (15) are deployed, the edges of the scanning bed are *not* covered. Rather, the edges of the scanning bed are almost entirely visible. Thus, SeseK cannot be reasonably construed as teaching the claimed “means for selectively *covering edges of a scanning bed* such that said means for scanning outputs no image markings when scanning said covered portions of said scanning bed” and “wherein said means for covering edges of said scanning bed are configured to selectively and statically reduce an effective scanning area of said means for scanning.”

Additionally, Takeda does not teach or suggest a “means for selectively covering edges of a scanning bed...wherein said means for covering edges of said scanning bed are configured to selectively and statically reduce an effective scanning area of said means for scanning.” As clearly seen in Fig. 8 of Takeda above, Takeda teaches light shielding plates used such that “the position at which the light from light source 16 is shaded changes as the plates are moved in relationship to pixel scanning line 22.” (Takeda, col. 6, lines 17-19). Thus, Takeda teaches that the light shielding plates are dynamically moved during the scanning process and consequently *cannot* “statically reduce an effective scanning area of said means for scanning” as recited in claim 20.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by SeseK and Takeda, did not include the claimed subject matter, particularly a scanning device comprising “means for selectively covering edges of a scanning bed such that said means for scanning outputs no image markings when scanning said covered portions of said scanning bed; wherein said means for covering edges of said scanning bed are configured

to selectively and statically reduce an effective scanning area of said means for scanning.”
(Claim 20).

The differences between the cited prior art and the claimed subject matter are significant because the system taught by Takeda requires the use of light shielding plates that are dynamically moved throughout the scanning processes by motors and Sesek requires the configuration of a scanner device to only scan a user-defined area. Both of these approaches require significant development and/or technological resources that are not required by the scanning device taught in claim 20. Thus, the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 20 under 35 U.S.C. § 103 and *Graham*. For at least these reasons, the rejection based on Sesek and Takeda of claim 20 and its dependent claims should be reconsidered and withdrawn.

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

Claim 7 recites “wherein said adjustable shade further comprises a shade reel including a spring and a lock mechanism.” Claim 10 recites that “said adjustable shades are configured to be drawn to a desired length, maintain said desired length for a desired length of time, and to be retracted by a spring and lock mechanism.” Claims 16, 17 and 23 recite similar subject matter. Neither Sesek nor Takeda teaches or suggests this subject matter. In this regard, the recent Office Action cites to elements 15a, 15b, 16a, and 16b of Fig. 1 in Sesek (Action, p. 4). However, Sesek refers to these elements as merely “pointers” (Sesek, paragraph 0028) and no spring or lock mechanism is shown in Fig. 1 or taught or suggested

anywhere else in Sesek or Takeda. For at least this additional reason, the rejection of claims 7, 10, 16, 17 and 23 should be reconsidered and withdrawn.

Claim 8 recites “wherein said opaque material is coiled around said shade reel.”

Claims 14-17 recite similar subject matter. As has been amply shown above, neither Sesek nor Takeda teaches or discloses a shade reel. Consequently, the rejection of claims 8 and 14-17 should be reconsidered and withdrawn for at least this additional reason.

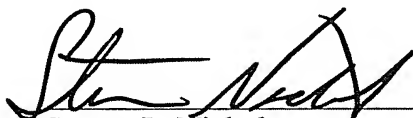
Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Steven L. Nichols', written over a horizontal line.

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Registration No. 40,326

DATE: July 29, 2008

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